

### **REMARKS**

After the above amendments, claims 1-16 and 23-25 are pending. Claims 1, 13, and 23 are independent.

#### **Status of Terminal Disclaimer**

In response to a double-patenting rejection, Applicant filed a Terminal Disclaimer on August 8, 2002. The examiner has withdrawn the double-patenting rejection, but it is not clear whether the Terminal Disclaimer has been made of record in this application. Applicant would appreciate clarification of the status of the disclaimer.

#### **Supplemental IDS**

Applicant has filed a Supplemental IDS concurrently with this Amendment. Applicant appreciates the Examiner's consideration of the Supplemental IDS.

#### **Rejection of Claims 1-16 and 23-25 Under 35 U.S.C. § 103(a)**

Claims 1, 4-6, 14, and 15 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,907,586 to Bille et al. in view of U.S. Patent No. 5,090,955 to Simon and U.S. Patent 3,776,230 to Neefe. Claims 2, 3, 7-13, and 15-25 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Bille et al. in combination with Simon and U.S. Patent No. 4,665,913 to L'Esperance, Jr.

Applicant requests reconsideration of these rejections because the proposed combination of references does not disclose or suggest all of the limitations of the rejected claims. In particular, each of the rejected independent claims includes steps relating to a "corneal flap"

which is not disclosed or suggested by the cited references. Independent claim 1 recites “firing the laser at the cornea . . . to form a corneal flap,” “lifting the corneal flap,” and “introducing an ocular implant in between the first and second internal surfaces of the corneal flap.” Independent claim 13 recites “firing the ultrashort pulse laser at the cornea . . . to form a corneal flap,” “lifting the corneal flap,” and “introducing a substantially ring-shaped ocular implant in between the first and second internal surfaces of the corneal flap.” Claim 23 recites “separating the internal area of the cornea . . . to form a corneal flap,” “lifting the corneal flap,” and “introducing a substantially ring-shaped ocular implant in between the first and second internal surfaces of the corneal flap.”

As seen most clearly in Fig. 90 and discussed at p. 51-52 of the subject application, these steps require firing a laser 1206 at the surface of the eye. This separates the internal area of the cornea offset from the main optical or visual axis 1222 into first and second substantially ring-shaped internal surfaces 1216 and 1218 to form a circular or ring-shaped corneal flap 1202. As seen in Figs. 91 and 103, the flap 1202 is then lifted using any device known in the art, such as spatula or microforceps or any other device, and lens 1208 is positioned or introduced around or at least partially encircling the main optical axis 1222 and in between the first and second internal surfaces 1216 and 1218 of the flap 1202. The flap 1202 is then replaced so that it covers or lies over the lens in a relaxed state, as seen in Fig. 104.

None of the four cited references, individually or in combination, discloses or suggests forming a corneal flap, lifting that flap, and implanting an ocular implant under the flap. Bille et al. relates to a laser used for eye surgery, and teaches using the laser to form pockets or T-cuts to correct for myopia, hypomyopia, or astigmatism. *See* col. 10, ll. 34-45. Bille et al. does not disclose or suggest forming a corneal flap, and lifting a corneal flap.

Simon relates to a method for implanting a synthetic gel into a pocket in the cornea. As seen in Fig. 9, Simon creates a pocket in the cornea by using a corkscrew delaminator 28. The pocket is then filled by a gel using a needle injector 32, as seen in Fig. 12. A pocket is not a corneal flap, and the method of Simon does not disclose or suggest forming a corneal flap, and lifting that corneal flap to place an implant under the flap.

Neeffe relates to reshaping the exterior surface of the cornea. It teaches reshaping the exterior surface using a combination of heat and chemicals. It does not disclose or suggest using a flap.

Finally, L'Esperance relates to ablating the cornea using an excimer laser. L'Esperance does not disclose or suggest forming a corneal flap, and lifting that corneal flap to place an implant under the flap.

Thus, none of the four patents discloses or suggests forming a corneal flap, and lifting that corneal flap to place an implant under the flap. The proposed combination of the four references, therefore, also does not disclose or suggest forming a corneal flap, and lifting that corneal flap to place an implant under the flap. Since none of the four references discloses or suggests the limitations relating to corneal flaps, the claims are in condition for allowance.

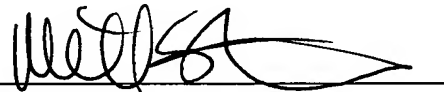
Furthermore, with respect to claims 10-16 and 23-25, each of these claims recites aiming and firing a second laser at the external surface of the cornea to ablate a portion of the external surface of the cornea. The Action apparently relies on L'Esperance as teaching this step. This is improper because the Action provides no motivation for using the method of L'Esperance in combination with the other three patents. Each of the other three patents—Bille et al., Simon, and Neeffe—individually discloses a particular method of reshaping a cornea to cure defects in the cornea. Likewise, L'Esperance teaches a method of reshaping a cornea by using an excimer

laser to cure defects in the cornea. Nothing in any of these patents suggests employing two separate and different methods of reshaping the cornea together. For example, Simon teaches a perfectly acceptable way of modifying the shape of the cornea. Nothing in the prior art suggests that one should use the perfectly acceptable method of Simon to reshape the cornea, and then subsequently use the method of L'Esperance to reshape the cornea again. There is simply no motivation provided in any of these references for combining L'Esperance with the other cited references. Accordingly, the rejection of the claims is improper for this additional reason.

In view of the above, it is believed that the above-identified application is in condition for allowance, and notice to that effect is respectfully requested. Should the Examiner have any questions, the Examiner is encouraged to contact the undersigned at the local telephone number indicated below.

Respectfully submitted,

Date: June 29, 2004

A handwritten signature in black ink, appearing to read 'Michael E. Stimson', written over a horizontal line.

Michael E. Stimson  
Reg. No. 41,333  
Attorney for Applicant

Roylance, Abrams, Berdo & Goodman, L.L.P.  
1300 19<sup>th</sup> Street, N.W., Suite 600  
Washington, D.C. 20036-2680  
(202) 659-9076